

ATTORNEY DOCKET NO. NL 010158 (PHIL06-00053)
U.S. SERIAL NO. 10/085,669
PATENT

REMARKS

Claims 1–20 are pending in the present application.

Claims 12–20 were added.

Reconsideration of the claims is respectfully requested.

35 U.S.C. § 102 (Anticipation)

Claims 1–3, 5–6 and 8–11 were rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,118,672 to *Yamauchi et al.* This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Independent claim 1 recites an antenna. Such a feature is not depicted or described in the cited reference. *Yamauchi et al* does not depict an antenna, and is silent as to an antenna. The element identified by reference character 7, cited in the Office Action as satisfying the limitation of an antenna, is merely described in *Yamauchi et al* as “the body 7 of the tuner.” *Yamauchi et al*, column 8, line 18.

The final Office Action states:

ATTORNEY DOCKET NO. NL 010158 (PHIL06-00053)
U.S. SERIAL NO. 10/085,669
PATENT

Applicant argues that Yamaguchi fails to anticipate his claim language because the antenna taught by Yamaguchi is not part of or affixed to the tuner structure. This is not persuasive because connector (52, 150) affixes the external antenna to the tuner structure of Yamaguchi and is interpreted to be a necessary element of the tuner structure.

Paper No. 9, page 6. Providing a connector (10, 52, 150) for connection of a tuner module to an antenna does NOT satisfy the claim limitation of an antenna as part of the tuner module.

Independent claim 1 further recites that the shield and the antenna are present substantially at the same side of the substrate as the semiconductor device. Such a feature is not depicted or described by the cited reference. *Yamauchi et al* depicts the connector 10 (including the feed-through capacitor 4 within connector 10) on an opposite side of circuit board 1 from chip 2.

Claim 3 recites that the antenna is a metal plate comprising first, second and third adjoining portions, where the second portion is substantially parallel to the substrate and the first and third portion are connected to electric conductors at one side of the substrate. Such a feature is not depicted or described by the cited reference. *Yamauchi et al* does not depict or describe an antenna, but instead merely depicts and describes a connector to an antenna.

Claim 5 recites that a support means between the shield and the antenna is a strip connected at a first end to the antenna and at a second end to the shield. Such a feature is not depicted or described by the cited reference.

Claim 7 recites that a support means between the shield and the antenna is a carrier for the antenna, is an electrically insulating material with first, second and third adjoining portions, where

ATTORNEY DOCKET NO. NL 010158 (PHIL06-00053)
U.S. SERIAL NO. 10/085,669
PATENT

the second portion is substantially parallel to the substrate and the first and third portion are connected to electric conductors at one side of the substrate, and is fastened to the shield. Such a feature is not depicted or described by the cited reference.

Claim 8 recites that a support means between the antenna and the shield is a carrier of both the antenna and the shield. Such a feature is not depicted or described by the cited reference.

Claim 9 recites that a support means between the antenna and the shield is a carrier of both the antenna and the shield, and includes first, second and third adjoining portions, where the second portion is substantially parallel to the substrate and the first and third portions extend to the substrate.

Such a feature is not depicted or described by the cited reference.

Claim 11 recites an electronic device including a tuner module with the features recited in claim 1 and a radiation emitting component both mounted on a carrier, the tuner module having a height from the carrier greater than a height of the radiation emitting component. Such features are not depicted or described by the cited reference.

Therefore, the rejection of claims 1-3, 5-6 and 8-11 under 35 U.S.C. § 102 has been overcome.

35 U.S.C. § 103 (Obviousness)

Claims 4 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,356,173 to Nagata *et al.* This rejection is respectfully traversed.

ATTORNEY DOCKET NO. NL 010158 (PHIL06-00053)
U.S. SERIAL NO. 10/085,669
PATENT

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach

ATTORNEY DOCKET NO. NL 010158 (PHIL06-00053)
U.S. SERIAL NO. 10/085,669
PATENT

or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

As noted above, independent claim 1 and claims 3, 5 7–9 and 11 each recite features not depicted or described in *Yamauchi et al.* Such features are also not depicted or described within the cited portions of *Nagata et al.*

Therefore, the rejection of claims 4 and 7 under 35 U.S.C. § 103 has been overcome.

ATTORNEY DOCKET NO. NL 010158 (PHIL06-00053)
U.S. SERIAL NO. 10/085,669
PATENT

SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at wmunck@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: May 9, 2003



William A. Munck
Registration No. 39,308

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: wmunck@davismunck.com